

**4 MONTH DUE DATE:** \_\_\_\_\_ (Ex: May 15, 2003)(red ink)

**REMAND DUE DATE:** July 14, 2004 (7 day due date, 1 week from today)

*16 AUG 04*

### **BOARD OF APPEALS ROUTING SLIP**

Art Unit: 2155 Serial No. 09/410,202

	<b>INITIALS</b>	<b>DATE REC'D</b>
DIRECTOR	<u>M</u>	<u>7/13/04</u>
QAS	<u> </u>	<u> </u>
SPE	<u> </u>	<u> </u>
EXAMINER	<u>DR</u>	<u>8/13/04</u>
LIE	<u> </u>	<u> </u>

#### **CHECK ONE:**

ALLOWED: \_\_\_\_\_ ABANDONED: \_\_\_\_\_ OTHER: \_\_\_\_\_

**\*Please return routing slip to Director's Office when case is completed.**

To: David Eng  
From: Peggy Focarino, Stew Levy, and Peter Wong, Directors TC 2100  
Date: August 5, 2004  
Re: Remand from the Board of Patent Appeals 09/410,202

The examiner's answer you prepared in the attached application has been reviewed and found to be defective for the following reasons:

The formulations of the 103 rejections are incomplete in that they lack motivation statements or contain incomplete motivation statements. Moreover, the examiner should not use language such as "can be executed", "can be retrieved" and "could have been executed" in making rejections, as this formulation fails to set forth a *prima facia* case of obviousness. For example, just because a method "can be" executed by a microprocessor doesn't mean that it is or would be obvious.

If the rejections can be reformulated to include proper motivation and remove terminology such as "can be" as discussed above, the examiner should prepare a supplemental examiner's answer. If new art is required in order to complete the rejections, prosecution should be reopened and new rejections made. If the rejections cannot be completed (i.e. art needed cannot be found), then it would appear that the application is in condition for allowance.

Corrective action as outlined above should be taken within one week of receipt of this memo. Once the non-final Office action or allowance has been prepared, the case must be given to the QAS shop for review and removal of the mailing flag.



UNITED STATES DEPARTMENT OF COMMERCE  
Patent and Trademark Office  
ASSISTANT SECRETARY AND COMMISSIONER  
OF PATENTS AND TRADEMARKS  
Washington, D. C. 20231

MEMORANDUM

TO: GROUP 2155 DIRECTOR

FROM: BOARD OF PATENT APPEALS AND  
INTERFERENCES

SUBJECT: ORDER REMANDING TO EXAMINER

We are forwarding this application to  
your Group for taking further action  
consistent with the decision of the Board  
remanding this appeal to the Primary Examiner.

Program & Resource Administrator  
Board of Patent Appeals and Interferences  
308-9797